

### Applicants Provisionally Elect With Traverse

In response to the Action dated April 24, 2001 requiring restriction election, Applicants provisionally elect with traverse Group III (claims 31, 35, 38, 41, 44, and 45). Newly added claims 48-54 would also be grouped with at least Group III.

However, as discussed in more detail below, it is respectfully submitted that the lack of unity of invention requirement ("restriction requirement") should be withdrawn for numerous reasons.

### The Alleged Groups Of Inventions

The present application is a U.S. national stage application filed under 35 U.S.C. § 371.

The Action alleges that the present application contains inventions or groups of inventions. The Applicants disagree. Applicants assert that the present claims relate to a common invention. Nevertheless, even if the present application relates to a group of inventions, it is respectfully submitted that each alleged group of inventions are so linked as to form a single general inventive concept.

For example, claim 21 was previously amended April 7, 2000 to be an independent claim by incorporation of subject matter of claim 1, from which it originally depended. Thus, Group II (which contains claim 21) cannot be regarded as not linked so as to form a single general inventive concept with Group I (which contains claim 1). Therefore, it is respectfully submitted that unity of invention exists at least between the alleged Groups I and II.

**The Office Admits That The Groups Share A Common Special Technical Feature**

The Action admits (numbered paragraph 2) that all of the alleged Groups I-V (“groups”) share a common special technical feature. That is, the Office acknowledges a “special technical feature” common to all of the listed groups. 37 C.F.R. § 1.475 makes clear that unity of invention exists when there is a relationship among a group of inventions involving a “special technical feature.” Hence, since the groups share a common special technical feature, which the Office freely admits, then it is respectfully submitted that unity of invention exists among all of the alleged groups in accordance with 37 C.F.R. § 1.475 and 37 C.F.R. § 1.499. Therefore, the restriction requirement is moot and should be withdrawn.

**No Evidence That The Action’s Alleged Technical Feature Is Well Known In The Prior Art**

The Action alleges a technical feature directed to “a note or document dispenser of a banking machine being in operative connection to a computer, said computer in connection with the banking machine.” The Action further alleges that “this technical feature discloses only that which is old in the art of banking machines and was well known to those of ordinary skill in the art at the time that the invention was made.” The Applicants disagree.

The Office has provided no evidence that the alleged technical feature is well known in the prior art. The Office further fails to discuss any prior art reference disclosing the alleged technical feature.

Furthermore, as previously discussed, the Office admits that all of the groups share a common special technical feature. The expression “special technical feature” is defined (37

C.F.R. § 1.475) as meaning a technical feature that defines a contribution which each of the inventions, considered as a whole, makes over the prior art. Thus, by definition, the Office's admission that the groups share a common special technical feature is also an acknowledgment that the features of the groups avoid the prior art.

**The Claimed Invention Is Entitled To A Date Prior To All Applied Art**

The earliest applied reference (U.S. Patent 5,761,071 to Bernstein in the Office Action dated February 17, 2000) has a July 27, 1996 filing date. The present application is entitled to the priority of U.S. provisional application 60/031,956 filed November 27, 1996. As previously discussed in the amendment filed April 7, 2000, Applicants' claims patentably distinguish over the Bernstein reference. Nevertheless, Applicants have submitted a Declaration herewith pursuant to 37 C.F.R. § 1.131. The Declaration swears behind the Bernstein reference. Thus, the Office has not presented one iota of evidence that the technical features (i.e., those alleged by the Office, and others later discussed herein by Applicants) are well known in the prior art.

**Allowable Subject Matter Establishes That Common Technical Features Were Not Previously Known**

The Office Action dated February 17, 2000 indicated allowable subject matter in claims 2-3 and 21-24. Claim 2 (Group I) and claim 21 (Group II) are presently independent claims, including subject matter of claim 1 from which they originally depended. Thus, because of the

Office's indication of allowable subject matter in these claims, the technical feature cannot be viewed as well known in the art.

### **The Action Fails To Consider All Special Technical Features**

As previously discussed, the Action alleges one technical feature directed to "a note or document dispenser of a banking machine being in operative connection to a computer, said computer in connection with the banking machine." However, it is respectfully submitted that (in accordance with 37 C.F.R. § 1.475) there is a technical relationship among the asserted groups involving one or more corresponding special technical features that the Office overlooked. That is, all asserted groups share a common special technical feature which the Office failed to consider.

For example, all of the claims (in various forms) are generally directed to the common special technical feature involving some type of banking machine responsive to the receipt of a markup language document to enable the dispense of a type of sheet. For example, in an exemplary embodiment, a banking machine is able to carry out one or more transaction functions, such as the dispensing of sheets, in response to an HTML document being received by the machine. The Office has provided no evidence that this common special technical feature is known in the prior art. Language generally corresponding to this special technical feature is shown as being common to each independent claim (1-2, 21, 31-32, 34-44, and 46) below. It should be understood that the following reference to claim language in this Response is

illustrative that this feature is common to the independent claims and is not associated with matters of patentability concerning prior art.

Claim 1

“operative responsive to the HTML document handling portion receiving an HTML format document including a dispense instruction to cause the sheet dispenser mechanism to dispense at least one sheet”

Claim 2

“operative responsive to the HTML document handling portion receiving a dispense instruction in an HTML format document, to enable the sheet dispenser mechanism to dispense at least one sheet”

Claim 21

“operative responsive to the HTML document handling portion receiving a dispense instruction in an HTML format document, to enable the sheet dispenser mechanism to dispense at least one sheet”

Claim 31

“the sheet dispenser mechanism is operative responsive to receipt of at least one HTML format document by the browser, to dispense at least one sheet from the ATM”

Claim 32

“dispensing at least one sheet from a sheet dispenser in the automated banking machine responsive to receipt by the browser of the HTML format document including the dispense instruction”

Claim 34

“dispensing at least one sheet from a sheet dispenser in the automated banking machine responsive to receipt by the browser of the document including the dispense instruction”

Claim 35

“responsive to receipt of at least one document by the browser, to enable the sheet dispenser mechanism to operate to dispense at least one sheet from the ATM”

Claim 36

“responsive to receipt by the browser of the document including the instruction in step (c), enabling a sheet dispenser in connection with the automated banking machine to operate to dispense at least one sheet”

Claim 37

“controlling a note dispenser in the automated banking machine responsive to receipt by the computer of the document including the instruction”

Claim 38

“the computer to operate to receive at least one document, and wherein the computer is operative responsive to the at least one HTML document to enable the sheet dispenser to dispense at least one sheet from the ATM”

Claim 39

“dispense of at least one sheet from a sheet dispenser in connection with the automated banking machine responsive to the computer receiving the document including the instruction”

Claim 40

“dispense of at least one note from the automated banking machine responsive to receipt by the computer of the HTML document including the instruction”

Claim 41

“computer is operative responsive to indicia read with the card reader to receive at least one document, and wherein the computer is operative to control the note dispenser in dispensing at least one note from the automated banking machine responsive to the at least one document”

Claim 42

“dispense of at least one note from the automated banking machine responsive to the at least one instruction included in the document received in step (b)”

Claim 43

“dispensing of at least one note from the banking machine responsive to the document received in step (c)”

Claim 44

“the computer is adapted to receive mark up language documents, and wherein the computer is adapted to operate responsive to at least one mark up language document to cause at least one note to be dispensed from the banking machine”

Claim 46

“computer to receive at least one mark up language document” “the computer responsive to the at least one mark up language document to cause at least one note to be dispensed from the banking machine”

**The Action Does Not Meet The Requirements Necessary For Restriction Requirement**

MPEP § 1893.03(d) states that “When making a lack of unity of invention requirement, the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group.”

The Applicants respectfully submit that the Office Action does not meet the requirement of item (1). The present application is not directed to different groups of claims. Thus, the listed groups are not “different.”

The Applicants also respectfully submit that the Office Action does not meet the requirement of item (2). Nowhere in the Action does the Office explain why each asserted group lacks unity with each other group. The Action does not compare any group with any other group. It follows that the Action does not compare each group with each other group. The five (5) alleged groups would require at least ten (10) separate comparisons. Yet Applicants have not received even one comparison. Thus, the Action does not meet the burden of item (2), which is necessary to sustain the restriction requirement. Since an explanation (item (2) has not been provided, then the Action also does not comply with the procedural rules of the Office. Thus, the restriction requirement is defective and should be withdrawn.

Furthermore, nowhere in the Action does the Office specifically describe "the unique special technical feature in each group." That is, the Action does not describe how each asserted group has a unique special technical feature not found in each other group. Again, the Action lacks any comparison whatsoever of any two groups. It follows that the Action lacks the required comparison of each individual group with each other individual group. Thus, the Action fails to specifically describe the unique special technical feature in each group, which is also necessary to sustain the restriction requirement.

The Action states that each of the “groups 1-5 share the special technical feature.” The Action also states that “this technical feature discloses only that which is old in the art of banking

machines and was well known to those of ordinary skill in the art at the time that the invention was made. Thus, unity of invention between the inventive groups is defeated.”

The Office’s reasoning that each group shares the same special technical feature is not a valid basis for asserting lack of unity of invention. Furthermore, the Office’s reasoning that each group shares an old technical feature is not a valid basis for asserting lack of unity of invention. The Office’s reasoning that each group shares technical features and thereby a common unity, is directly contrary to the assertion that each group lacks a common unity.

The Action’s statements, by indicating that each group shares in unity the same special technical feature, actually shows that unity of invention is present and that the Office has not met the requirements for restriction. That is, the Action literally contradicts the Office's assertion that each group lacks unity with each other group. In other words, the Action’s admission that each of the groups share a common unity, is the opposite to what the Office must prove before imposing a lack of unity requirement. It follows that the Action itself actually establishes that the restriction requirement is not appropriate.

It is respectfully submitted that the restriction requirement is incomprehensible, conflicting, and incomplete. It follows that the restriction requirement is defective. The Action leaves Applicants the burden of properly responding to a defective requirement. On this basis it is further respectfully submitted that the requirement should be withdrawn.

**Applicants' Process And Apparatus Claims Are Entitled To Unity Of Invention**

It is respectfully submitted that the relationship between the process and apparatus claims has not been properly considered. A national stage application will be considered to have unity of invention with claims drawn to a process and an apparatus designed for carrying out the process (37 C.F.R. § 1.475). There is no evidence that the Office ever considered the relationship between the process and apparatus claims. It follows that the Action further does not meet the requirements necessary for restriction requirement. Thus, the Action is further defective. On this basis it is respectfully submitted that the requirement should be withdrawn.

It is respectfully submitted that the application has apparatus claims drawn to apparatus capable of carrying out process claims. Hence, in accordance with 37 C.F.R. § 1.475 the application has unity of invention. Thus, the alleged groups have unity of invention.

For example, the apparatus of claim 44 (Group III) is designed for carrying out the process of claim 46 (Group IV). Thus, Groups III and IV clearly have unity of invention. The other groups likewise show some relationship between process and apparatus claims. For brevity only one comparison example (using claims 44 and 46) is provided. The below described relationship of claims 44 and 46 show that the apparatus (claim 44) can carry out the process (claim 46):

<u>Claim 44 apparatus feature</u>	<u>can carry out the</u>	<u>Claim 46 process step</u>
an automated banking machine comprising a computer, wherein the		(a) operating a computer in an automated banking machine, wherein the computer is adapted to

computer is adapted to receive mark up language documents; receive mark up language documents;

wherein the computer is adapted to receive mark up language documents; (b) operating the computer to receive at least one mark up language document;

wherein the computer is adapted to operate responsive to at least one mark up language document to cause at least one note to be dispensed from the banking machine. (c) operating the computer responsive to the at least one mark up language document to cause at least one note to be dispensed from the banking machine.

### **The Definitions And Relationships Of The Alleged Groups Are Improper**

Group I is allegedly directed to a banking machine comprising a computer.

Group II is allegedly directed to an apparatus comprising a home http server having a home address, said apparatus also comprising a banking machine, said banking machine further comprising a computer. However, it is noted that Group I is also directed to a banking machine comprising a computer. Thus, the alleged different groupings is improper.

Group III is allegedly directed to an automated teller machine. However, it is noted that the Group III independent claims 41 and 44 (and claims 31, 35, and 38 amended herewith) are directed to an automated banking machine. Thus, the alleged grouping is improper.

Group IV is allegedly directed to a method of operating the computer of an automated banking machine to dispense at least one note. However, it is noted that independent method claim 43, which is listed with Group V, is also directed to operating the computer of an automated banking machine to dispense at least one note. Thus, the alleged different groupings are improper. Also note claims 37, 40, and 42.

Group V is allegedly directed to a method comprising operating a browser in at least one computer in connection with an automated banking machine. However, it is noted that independent method claims 39, 40, 42, and 43 do not even mention a browser. Thus, the alleged grouping is improper.

**Unity Of Invention Exists Between The Alleged Groups**

**Groups I and II**

Alleged Group II contains independent claim 21. As previously discussed, claim 21 was previously amended April 7, 2000 to be an independent claim by incorporation of subject matter of claim 1 (Group I), from which it originally depended. Thus, Group II (which contains claim 21) cannot be regarded as not linked so as to form a single general inventive concept with Group I (which contains claim 1). Furthermore, the Action admits that Group II contains all of the features drawn to Group I. That is, the Action admits that Group II includes the Group I features of “a banking machine comprising a computer.” Therefore, it is respectfully submitted that unity of invention exists between the alleged Groups I and II.

### Groups I and III

The Action directs Group I to “a banking machine comprising a computer.” However, claims 41 and 44 (and claims 31, 35, and 38 amended herewith) of the alleged Group III also have a banking machine comprising a computer. Therefore, it is respectfully submitted that unity of invention exists between the alleged Groups I and III.

### Groups I and IV

The Action directs Group I to “a banking machine comprising a computer.” However, claim 46 of the alleged Group IV also has a banking machine comprising a computer. Furthermore, the Office has not shown that the apparatus of Group I is not capable of carrying out the process of Group IV. That is, the Office has not shown that the apparatus of Group I is not capable of dispense. Therefore, it is respectfully submitted that unity of invention exists between the alleged Groups I and IV.

### Groups I and V

The Action asserts that Group I is directed to “a banking machine comprising a computer.” The Action states Group V is directed to a computer in connection with a banking machine. Hence, the Action admits that Group V contains all of the features drawn to Group I. That is, the Action admits that Group V includes the Group I features of “a banking machine comprising a computer.” Therefore, it is respectfully submitted that unity of invention exists between the alleged Groups I and V.

Groups II and III

It is respectfully submitted that claims 41 and 44 (and claims 31, 35, and 38 amended herewith) of the alleged Group III are directed to a banking machine comprising a computer. Hence, alleged Group III corresponds to alleged Group II which is also directed to a banking machine comprising a computer. Therefore, it is respectfully submitted that unity of invention exists between the alleged Groups II and III.

Groups II and IV

The Action asserts that Group IV is directed to a method of operating the computer of an automated banking machine to dispense at least one note. However, the Office has not shown that the apparatus of Group II is not capable of carrying out the process of Group IV. That is, the Office has not shown that the apparatus of Group II is not capable of dispense.

Furthermore, the Action asserts that Group II is directed to a banking machine comprising a computer. However, claim 46 of the alleged Group IV also has a banking machine comprising a computer. Therefore, it is respectfully submitted that unity of invention exists between the alleged Groups II and IV.

Groups II and V

Group V is directed to a method comprising operating a browser in at least one computer in connection with an automated banking machine. As previously mentioned, claims 39, 40, 42, and 43 do not even mention a browser. The Office has not shown that the apparatus of Group II is not capable of carrying out the process of these Group V claims. Furthermore, the Action asserts that Groups II and V are both directed to having a banking machine comprising a

computer. Therefore, it is respectfully submitted that unity of invention exists between the alleged Groups II and V.

Groups III and IV

The Action asserts that Group III is directed to an “automated teller machine comprising a computer.” However, it is noted that independent claims 41 and 44 (and claims 31, 35, and 38 amended herewith), which are listed with Group III, are directed to a banking machine comprising a computer. Claim 46 of the alleged Group IV also recites a banking machine comprising a computer. Furthermore, as previously discussed in detail, claim 44 of Group III is capable of carrying out the process of Group IV claim 46. Therefore, it is respectfully submitted that unity of invention exists between the alleged Groups III and IV.

Groups III and V

The Action asserts that Group III is directed to an “automated teller machine comprising a computer.” However, as previously discussed, it is respectfully submitted that the alleged Group III claims 41 and 44 (and claims 31, 35, and 38 amended herewith) are directed to a banking machine comprising a computer. The Action asserts that Group V is directed to a computer in connection with a banking machine. Hence, the Action admits that Group V contains all of the features attributed to Group III. Therefore, it is respectfully submitted that unity of invention exists between the alleged Groups III and V.

Groups IV and V

The Action asserts that Group V is directed to a method comprising operating a browser in at least one computer in connection with an automated banking machine. As previously mentioned, claims 39, 40, 42, and 43 do not even mention a browser. Thus, the Group V language drawn to a computer in connection with an automated banking machine, generally corresponds to the alleged Group IV language drawn to a computer in an automated banking machine. Therefore, it is respectfully submitted that unity of invention exists between the alleged Groups IV and V.

Furthermore, the alleged Group IV has language directed to dispense of at least one note. However, it is noted that independent method claim 43, which are listed with Group V, also has language directed to dispense of at least one note. Also note claims 37, 40, and 42. Therefore, it is respectfully submitted that unity of invention exists between the alleged Groups IV and V.

**The Dependent Claims Have Not Been Considered**

MPEP § 1850 indicates that if an independent claim does not avoid the prior art, then the question whether there is still an inventive link between all of the claims dependent on that claim needs to be carefully considered.

As previously discussed, the independent claims avoid the prior art and satisfy the requirement of unity of invention. Nevertheless, Applicants also assert that the dependent claims have an inventive link. Any inventive link between dependent claims must be absent before a holding of lack of unity of invention is proper. However, there is no evidence that the Office

ever considered whether there existed an inventive link between the dependent claims. Nor has the Action established the absence of any inventive link between dependent claims, so as to overcome the assertion by Applicants that an inventive link exists. It follows that the Action further does not meet the requirements necessary for restriction requirement. Thus, Applicants submit that the Action is further defective. On this basis it is respectfully submitted that the requirement should be withdrawn.

**Unity Of Invention Was Already Determined By The Office**

The present application is a national stage (filed under 35 U.S.C. § 371) application of PCT/US97/21422. The Office in that PCT application determined that there was no lack of unity of invention. Therefore, the Office has already admitted that unity of invention exists. Hence, it is respectfully submitted that the restriction requirement should be withdrawn.

**Versions With Markings To Show Changes Made**

**In the Claims**

31. (once amended) An automated banking machine [Automated Teller Machine (ATM)] comprising:

a computer;

a browser operating in the computer;

a sheet dispenser mechanism in operative connection with the computer, wherein the sheet dispenser mechanism is operative responsive to receipt of at least one HTML format document by the browser, to dispense at least one sheet from the automated banking machine [ATM].

35. (once amended) An automated banking machine [Automated Teller Machine (ATM)] comprising:

a computer;

a browser operating in the computer;

- a card reader in operative connection with the computer;
- a sheet dispenser mechanism in operative connection with the computer, wherein the computer is operative responsive to reading indicia on a card with the card reader to cause the browser to receive at least one document, and wherein the computer is operative responsive to receipt of at least one document by the browser, to enable the sheet dispenser mechanism to operate to dispense at least one sheet from the automated banking machine [ATM].
38. (once amended) An automated banking machine [Automated Teller Machine (ATM)] comprising:
- a computer including HTML document handling software operating in the computer;
- a card reader in operative connection with the computer;
- a sheet dispenser in operative connection with the computer, wherein the computer is operative responsive to reading indicia on a card with the

card reader to cause the computer to operate to receive at least one HTML document, and wherein the computer is operative responsive to the at least one HTML document to enable the sheet dispenser to dispense at least one sheet from the automated banking machine [ATM].

## CONCLUSION

The lack of unity of invention requirement is respectfully traversed. None of the alleged Groups lack unity of invention with any of the other alleged Groups. Therefore, it is respectfully requested that the lack of unity of invention requirement be reconsidered and withdrawn.

For brevity the Applicants have not necessarily presented all the reasons as to why the lack of unity of invention requirement should be withdrawn. Applicants reserve the right to later present additional reasons. Nevertheless, Applicants have presented arguments showing that unity of invention exists.

Applicants have effectively "sworn behind" all applied art. Allowance of all the pending claims is requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,



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